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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,542	08/03/2001	Daniel L. Schwarz	P-5204	6838

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EXAMINER
SORKIN, DAVID L

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/921,542	Applicant(s) SCHWARZ ET AL.
	Examiner David L. Sorkin	Art Unit 1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Duty to Disclose Information Material to Patentability

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ilg (US 3,328,255). Regarding claim 1, Ilg ('255) discloses a system comprising a sample vessel (2); a sample vessel holder (98), adapted to receive at least on said sample vessel and maintain said sample vessel in a position such that the longitudinal axis of said sample vessel extends at an angle substantially less than 90 degrees with respect to horizontal (see col. 8, lines 56-66); a stirrer (94) within said sample vessel; and a magnetic drive (96), adapted to move a magnet proximate to an outer surface of said sample vessel to permit said magnet to impose a magnetic influence on said stirrer to move said stirrer in said sample vessel (see col. 8, lines 45-70; Fig. 2). While Ilg

('255) happens to explicitly disclose the angle being substantially less than 90 degrees as discussed above, because the claim does not require an angle of the vessel relative to any other claimed element, it is considered that the recited angle is a matter of intended use. It is also noted that the claim does not recite the angle with respected to the claimed vessel, but instead with respect to an adaptation or capability of the holder to hold a vessel at an angle of substantially less than 90 degrees. "The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). Also, "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do; however, "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Nonetheless, as best seen in Fig. 2, the magnet driver of IIIg ('255) is adapted to move said magnet such that said mangetic influence moves said stirrer along a side wall of said sample vessel as stipulated in claim 6. Likewise, the system of IIIg ('255) is capable of being used in the manner discussed in claims 7, 9, and 10. Claim 8 only discusses a magnet which is not recited as part of the claimed apparatus and therefore does not further structurally limit the claimed apparatus.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Karkos, Jr. et al. (US 6,095,677). Regarding claim 1, Karkos ('677) discloses a system

comprising a vessel (22); holder (50) capable of receiving the vessel; a stirrer (including 34, 52,78,24) and a magnet driver (26). While the system is capable of performing the intended operations discussed in the claim, applicant is advised that "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Also, "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Furthermore, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967) and "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto,* 136 USPQ 458,459 (CCPA 1963). Regarding claim 2, a magnet shaft assembly (including shaft 70) having a magnet coupled thereto and a motor (28) are disclosed. Regarding claim 3 the magnet shaft assembly is rotatable (see col. 5, lines 60-65). See the decisions cited above regarding the intended use(s) discussed in the claim. Regarding claim 4, said motor is magnetically coupled to the shaft assembly (see col. 5 line 42 to col. 6 line 4). Regarding claim 5, said stirrer includes a ferrous metal (see col. 6, lines 62-64). The "magnet" mentioned in claim 5 is not positively recited as part of the claimed apparatus; however, a magnet imposing magnetic influence on said ferrous material is disclosed in col. 7, lines 1-3. Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do, however, "apparatus claims cover what a device *is*, not what a device

does" *Hewlett-Packard Co. v. Bausch & Lomb Inc, supra.* Claim 8 only discusses a magnet which is not a positively recited element of the claimed apparatus.

5. Claims 1 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ullman (US 5,120,135). Regarding claim 1, Ullman ('135), discloses a system comprising a sample vessel (12); a holder (28); a stirrer (18) and a driver (29) (see Fig. 8; col. 7, lines 32-47). While the system is capable of performing the intended operations discussed in the claim, applicant is advised that "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* supra. Also, "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham,* supra. Furthermore, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* supra. and "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto,* supra. Regarding claim 5, stirrer (18) including a ferrous metal according to claim 5 is disclosed (see col. 6, lines 31-56). The "magnet" mentioned in claim 5 is not positively recited as part of the claimed apparatus; however, a magnet imposing magnetic influence on said ferrous material is disclosed in col. 7, lines 1-3. Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do, however, "apparatus claims cover what a device *is*, not what a device *does*" *Hewlett-Packard Co. v. Bausch & Lomb Inc, supra.* Nonetheless, regarding claim 6, Ullman ('135) also discusses the intended use of moving a magnet (20,32) intended to be used with the

claimed system such that it moves the stirrer (18) along a side wall of the sample vessel (12) (see, for example, abstract and Figs. 1-3). Likewise, regarding claim 7, Ullman ('135) also discloses the intended use of moving a magnet (20,32) intended to be used with the claimed system away from an outer surface of the sample vessel (12) to allow gravity to move a stirrer (18) toward a bottom of said sample vessel (see Figs. 1-3 and col. 6 line 65 to col. 7 line 18). Claim 8 only discusses a magnet which is not positively recited as part of the claimed system.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilg (US 3,328,255) in view of Rosinger (US 2,350,534). The system of Ilg ('255) was discussed above with regard to claim 1. While it is considered that Ilg ('255) discloses all the limitations of claim 1 as set forth above, it is alternatively considered that the claim would have been obvious to one of ordinary skill in the art in view of Rosinger ('534). Specifically, it is considered that it would have been obvious to have provided a driver according to the teachings of Rosinger ('534) as the "rotating magnetic field generating device 96 of conventional design" of Ilg ('255) (quoting from col. 8, lines 50-52). Rosinger ('534) teaches a system including a magnetic driver (14, 15, 26) and stirrer (29). The magnetic driver (14,15) is adapted to drive a magnet (25). It is

considered that it would have been obvious to one of ordinary skill in the art to have provided a magnet driver according to the teachings Rosinger ('534) as the "rotating magnetic field generating device 96 of conventional design" of Ilg ('255), because the term "convention design" would have suggested to one of ordinary skill in the at to look to conventional magnet drivers such as that of Rosinger ('534). Regarding claim 2, in the driver taught by Rosinger ('534), a magnet shaft assembly (15, 26) has a magnet (25) coupled thereto; and a motor (14). Regarding claim 3, said magnet shaft assembly (15,26) is rotatable (see col. 2, lines 24-31). Regarding claim 5, Rosinger ('534) further teaches a stirrer including a ferrous metal (see col. 1 of page 2, line 21). Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do; however, "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Claim 8 only discusses a magnet which is not recited as part of the claimed apparatus and therefore does not further structurally limit the claimed apparatus.

Response to Arguments

8. Applicant argues that Karkos (6,095,677) does not disclose orienting the sample vessel "at an angle substantially less then 90 degrees". Firstly, the claims do not require that the claimed sample vessel be at such an angle, but instead the claims discuss the angle in regard to an adaptation or capablity of a sample holder. Additionally, and separately, the claims do not require the sample vessel (or the hypothetical sample vessel the holder may or may not be holding) to be oriented at less than 90 degrees relative to any other claimed element. The angle referred to in the

claim can be achieved by the manner in which the device is used. Obviously, one could place the blender of Karkos on a slanted surface and it is thus capable of being used in the claimed manner. Like wise the apparatus of Ullman ('135) is capable of being used such that the intended angle is achieved.

9. Applicant argues that Ullman ('135) does not disclose the method step of "stirring". However, no method claims are currently pending. Also, the usage of a particular word in a particular reference may or may not be the broadest reasonable interpretation of the word consistent with the instant application, which the examiner is required to use. Applicant discusses methods of operating the device of Ullman ('135); however, applicant does not relate such discussion to the claimed apparatus. Just because Ullman ('135) discloses a method that applicant has not disclose or has not claimed, is not a reason for the claimed apparatus to be allowed.

10. Applicant has not pointed out any claimed structural element or structural relationship between elements which the applied references fail to satisfy.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David Sorkin

July 22, 2003

TONY G. SOOHOO
PRIMARY EXAMINER